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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,278	05/18/1999	DAVID M. GOLDENBERG	DMGO:001US	3688
37013 7590 11/19/2008 ROSSI, KIMMS & McDOWELL, LLP. 20609 Gordon Park Square, Suite 150 Ashburn, VA 20147			EXAMINER AL HASHEMI, SANA A	
			ART UNIT	PAPER NUMBER
			2169	
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			11/19/2008 PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/313,278

**Applicant(s)**

GOLDENBERG, DAVID M.

**Examiner**

Sana Al-Hashemi

**Art Unit**

2169

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 39-51 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 39-51 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This action is issued in response to amendment filed 10/31/08.

Claims 39-51 are pending.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 39-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. (U.S. Patent 6,039,688) in view of Nicol et al. (U.S. Patent 5,287,448).

Claim 39: FIG. 1 illustrates a patient and a physician connected to a system interface (18). Any communication made by the physician or patient to the system interface is considered an inquiry from a user. The physician and patient can access different services, with each service being considered a "level of service".

(I) First level of service: Col. 14, lines 38-52 of Douglas et al. describe a first level of service. Col 14, line 40 describe a user generating information about the rewards points system and their own reward points, which occurs by clicking the icon (92) in Fig. 9. The searching of the database in this case is the searching of the record in the computer system containing user's

number of accumulated points and identifying the accumulated points, as well as details of the rewards system. The results of the search are delivered to the user by allowing the user to view the information (col. 14, line 40).

Douglas differs in that it does not determine a level of user sophistication, or tailor the resulting information based on that sophistication. However, col. 8, lines 35-46 of Nicol et al. describe a help menu feature added to a user interface, in which a user enters their relative level of sophistication, such as "novice", "moderate", or "experienced". The search results then presented to user in response to an information request is then specifically tailored to the input sophistication. A more experienced user will receive less information and a less experienced user will receive more information.

Accordingly, it would have been obvious to one of ordinary skill in the art to modify Douglas et al. to incorporate a help menu at any one or all of its user interfaces for input of user sophistication so as to tailor the specific output results to the user's level of sophistication. This provides the advantage of outputting appropriate messages to aid the user (col. 2, lines 46-47 of "Nicol et al). (All remaining quotations herein are from Douglas et al.).

Claim 40: (II) Second level of service: Col. 16, lines 21-55 describe a second level of service, in which searches are made on the database (computer system) in order to locate "more information", such as a list of articles and internet sites. (III) Third level of service: FIG. 48 illustrates a third level of service in which a user (Fred) is provided with a list of healthcare professionals (Susan). The user (Fred) is referred to the health professional (Susan) via the on/-outline a fourth level of service is which the physiological condition (vital signs, blood pressure,

weight) are monitored. Col. 6, lines 7-13 outline the administration of treatment by ordering that the patient take certain medications or participate in support groups.

Claims 41-43: The method steps defined by Douglas et al. meet each of parts (A), (B) and (C) defined in claim 40.

Claim 44: The levels of service may be accessed in any order. For example, the user can perform a search of articles and Internet sites (Second Level) before having an on-line meeting with health professional (Third Level of Service). After a given period of time, the user can take recommended medications or participate in support groups (Fourth Level of Service), such as the next day after meeting with the health professional.

Claims 45-47: The method steps defined by Douglas et al. meet each of parts (B) and (C) as defined in claim 40.

Claim 48: FIG. 57 of Douglas et al. illustrates a utilization review system. The user preference is the norm established for the percentage of patients which are desired to be using the system (The listed norm is 17.3%). The weighing function is the measurement of each physician's percentage of patients who participate in the program. The physicians are thus ranked by the percentage of the patients under their supervision who participate in the program. The selection of the user is the designation of which physicians are on the list shown in FIG. 57.

Claim 49: The method of Douglas et al. includes step (C) from claim 40.

Claim 50: As described at col. 6, line 7-13, the user can be instructed via the system to take a medication. These are the telemedicine signals sent to the patient. The implanted device is thus whatever drug the user is asked to take and which releases chemicals into the body.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Douglas et al. in view of Official Notice.

Claim 51: Within the system of Douglas et al., the user can be asked remotely to take medication, but is not asked to undergo surgery. However, Examiner takes Official Notice that the concept of having a physician ask a patient to undergo surgery is very well known in the context of physician - patient interaction. It would therefore have been obvious to one of ordinary skill in the art to modify Douglas et al. to include a recommendation to the remote patient that the patient undergo surgery so as to improve the patient's health and prevent or eliminate disease as is well known in the art.

#### ***Response to Arguments***

Applicant's arguments filed 10/31/08 have been fully considered but they are not persuasive.

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant argues "there is no suggestion that level of service should be based on user inquiry".

Examiner disagrees. The combined art discloses the argued limitations, by incorporating the options disclosed in the Nicol reference of (novice, moderate, or experienced) which are different level of options to be selected by the user in the Douglas system, the limitation has been met.

Applicant argues the applied of Douglas in view of the official notice failed to disclose the “administering treatment to the use comprise transmitting telemedicine signal over a network to perform remote surgery”.

Examiner disagrees. As stated in the rejection dated 11/1/07, the physician collect the information from a remote patient in this case the physician can be interpreted as administering treatment, since he is the one will be transmitting the medicine over the network. Further more as shown in Fig. 60, step 1002, wherein the physician enter the patient information and in step 1030 wherein the physician periodically update the patient information which include any treatment. Therefore the Examiner believes the argued limitation has been met.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Point of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sana Al-Hashemi whose telephone number is 571-272-4013. The examiner can normally be reached on 8Am-4:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pierre Vital can be reached on 571-272-4125. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sana Al-Hashemi/  
Primary Examiner, Art Unit 2169  
11/18/08